

Atty. Docket No. YOR920030531US1  
(590.123)REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 1-3, 5-7, 9-14, 16-18, and 20-23 are currently pending for examination, of which claims 1, 12 and 23 are independent; the remaining claims are dependent claims. Independent claims 1, 12 and 23 have been rewritten to incorporate the subject matter of dependent claims 8 and 19, which the Examiner previously indicated as containing allowable subject matter; claims 8 and 19 have been cancelled. Applicants intend no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Objections to the claims:

The Examiner apparently objects to claims 1-3, 5-14 and 16-22 for informalities relating to asserted indefiniteness in independent claims 1 and 12. Specifically, the Examiner asserts that claims 1 and 12 are indefinite because of the following: the relationship between the computer chips and the plurality of components is unclear. It is unclear how the soft-error testing is being performed and what components are being employed in this testing. It is unclear what comprises "an arrangement for automatically

Best Available Copy

Atty. Docket No. YOR920030531US1  
(590.123)

altering a configuration. And it is unclear what comprises "a position formerly occupied."

With regards to these objections Applicants respectfully submit that the definiteness of claim language is not determined in a vacuum but in light of the content of the specification, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art. MPEP § 2173.02. The Examiner must consider the claim as a whole to determine whether the claim language apprises one of ordinary skill in the art of the scope of the claim and therefore serves the notice function by providing clear warning to others as to what constitutes infringement. MPEP § 2173.02.

With regards to the relationship between "computer chips and a plurality of components," the Specification in Figures 1-3 and on page 6 lines 1-16 clearly describes the types of components that comprise the current invention. One of ordinary skill in the art, given content of the Specification, would be apprised of the scope of the claims with regards to "a plurality of components." Further detail is not needed to satisfy the notice requirement.

With regards to how soft error testing is being performed and what components are being used, the Specification in Figures 1-3 and in the Detailed Description, clearly sets forth the testing process using the current invention and the components that can be used therein. Applicants also respectfully point out that the current claims are directed towards "[a]n apparatus for automatically exchanging components in soft-error testing of computer chips (claim 1)," "[a] method of automatically exchanging components in soft-error testing of computer chips (claim 12)," and "[a] program storage device readable by

Test Available Cop

Atty. Docket No. YOR920030531US1  
(590.123)

machine, tangibly embodying a program of instructions executable by the machine to perform method steps for automatically exchanging components in soft-error testing of computer chips (claim 23)." Not towards a process for soft-error testing itself. One of ordinary skill in the art, given content of the Specification, would be apprised of the scope of the claims in this regard. Further detail is not needed to satisfy the notice requirement.

With regards to what comprises "an arrangement for automatically altering a configuration" and "a position formerly occupied," the Specification in Figures 1-3, on page 7 lines 5-19, and on page 8 line 15-page 9 line 10 clearly describes the operation of the current invention. One of ordinary skill in the art, given content of the Specification, would be apprised of the scope of the claims with regards to "an arrangement for automatically altering a configuration" and "a position formerly occupied." Further detail is not needed to satisfy the notice requirement.

For the foregoing reasons, Applicants respectfully submit that the current claims adequately set forth the subject matter that Applicants regard as the invention and fully satisfy the notice requirement. Applicants respectfully request that the Examiner withdraw the objections to claims 1-3, 5-14 and 16-22.

Should the Examiner continue to have concerns with regards to claim language or if the Examiner has specific claim language in mind that the Examiner believes will more clearly set forth the subject matter of the claims without limiting the scope of the claims, the undersigned requests the courtesy of a telephone interview to discuss the Examiner's concerns/suggestions.

**Rejection of claims under 35 U.S.C. § 103(a) over Homma ('395) in view of Jongen ('336):**

Claims 1-3, 11-14, 22, and 23 stand rejected as being unpatentable over U.S. Patent 5,584,395 to Homma (hereinafter Homma ('395)) in view of U.S. Patent 6,433,336 to Jongen et al. (hereinafter Jongen ('336)) under 35 U.S.C. § 103(a).

With regards to this rejection, Applicants' remarks in the Response dated March 28, 2006 are still applicable to the current rejection and hereby fully incorporated into this Response. In the interests of expediting prosecution, however, Applicants have amended independent claims 1, 12, and 23 to incorporate the subject matter of dependent claims 8 and 19, which the Examiner previously indicated as containing allowable subject matter.

Applicants respectfully submit that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered as a whole including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

Applicants respectfully submit that claims 1, 12, and 23, as amended, are fully allowable and distinguishable over the teachings both Homma ('395) and Jongen ('336) either separately or in combination. Neither reference teaches or discloses "at least one

Atty. Docket No. YOR920030531US1  
(590.123)

additional main body adapted to exchange components in soft-error testing of computer chips" as is currently claimed. Continued rejection on this basis would therefore be improper.

For the foregoing reasons, Applicants respectfully submit that claims 1-3, 11-14, 22, and 23 are allowable over Homma ('395) and Jongen ('336). Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 11-14, 22, and 23 as being unpatentable over Homma ('395) in view of Jongen ('336) under 35 U.S.C. § 103(a).

In view of the foregoing, it is respectfully submitted that independent claims 1, 12, and 23 are fully distinguishable over the applied art and are thus immediately allowable. By virtue of dependence from allowable independent claims, it is thus also submitted that claims 2, 3, 5-7, 9-11, 13, 14, 16-18, and 20-22 are also allowable at this juncture.

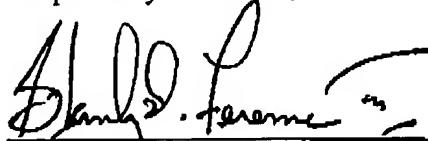
/  
/  
/  
/  
/  
/  
/

Best Available Copy

Atty. Docket No. YOR920030531US1  
(590.123)

In summary, it is respectfully submitted that the instant application, including claims 1-3, 5-7, 9-14, 16-18, and 20-23, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Stanley D. Ference III  
Registration No. 33,879

**Customer No. 35195**  
FERENCE & ASSOCIATES  
409 Broad Street  
Pittsburgh, Pennsylvania 15143  
(412) 741-8400  
(412) 741-9292 - Facsimile

Attorneys for Applicants

Best Available Copy